

**REMARKS**

Claims 1-7, 9, 11-24, 26-30, and 33-39 are pending in the application.

Claims 1-7, 9, 11-24, 26-30 and 33-38 stand rejected.

Claims 1-3, 17-19, 23-24, 26, 28-30, and 35-36 have been amended. Support for these amendments can be found at least in FIG. 6b and ¶ [0068], FIG. 3 and ¶¶ [0035]-[0038], and ¶ [0063] of the specification.

Applicants note that a typographical error on page 1 of the Office Action leaves claim 11 off the lists of pending and rejected claims.

**Claim Objections**

Claim 39 has been objected to under 37 C.F.R. 1.75(c), as purportedly being of improper dependent form for failing to further limit the subject matter of a previous claim since it “recites the same limitations as claim 9, verbatim.” *See* Office Action, p. 2. However, as acknowledged by the Office Action, claim 9 was previously amended to recite:

9. The method of claim 1 further comprising assessing an adoption level of an automated technology by the organization based on the one or more business challenges and the industry and revenue data.

*See* Office Action, p. 2. As also acknowledged by the Office Action, claims 39 was previously added (*Id.*), and it recites:

39. The method of claim 9 wherein the automated technology is at least one of customer relationship management (CRM), partner relationship management (PRM), and employee relationship management (ERM).

Thus, claim 39 does not recite the same limitations of claim 9, verbatim, and it does further limit the subject matter of claim 9. Therefore, Applicants respectfully request the withdrawal of the objection against claim 39.

*Rejection of Claims under 35 U.S.C. §101*

Claims 1-8, 9, and 11-22 stand rejected under 35 U.S.C. §101 since it is purported that they are “not tied to a particular machine and could be performed by a series of mental steps.” *See Office Action*, p. 3. Since independent claims 1 and 17 have been amended to address this rejection, Applicants respectfully request the withdrawal of the rejection against independent claims 1 and 17 as well as against dependent claims 2-7, 9, 11-16, and 18-22. Applicants respectfully submit that the rejection of claim 8 is moot since claim 8 has been previously canceled.

*Rejection of Claims under 35 U.S.C. §112*

Claims 1-7, 9, 11-24, 26-30 and 33-38 stand rejected under 35 U.S.C. §112, first paragraph, as purportedly failing to comply with the enablement requirement. *See Office Action*, p. 3. The Office Action asserts that the specification fails to provide sufficient disclosure in describing the limitation of independent claims 1, 17, 23, 26, 28, and 35 directed toward estimating benefits that are to be gained by an organization when one or more business challenges are successfully addressed. *Id* at 4.

However, the specification devotes ¶¶ [0059]-[0065] to a discussion of one embodiment of a process “for assessing benefits that a company can gain from addressing its business challenges.” These paragraphs are reproduced below for convenience:

[0059] **Figure 5** is a flow diagram of one embodiment of a process 500 for assessing benefits that a company can gain from addressing its business challenges. The process may be performed by processing logic that may comprise hardware (e.g., circuitry, dedicated logic, etc.), software (such as run on a general purpose computer system or a dedicated machine), or a combination of both.

[0060] Referring to **Figure 5**, processing logic begins with determining metrics applicable to user-identified most important business challenges (processing block 502). Metrics are referred to statistical data identifying high impact and low impact on various benefit groups. The benefit groups correspond to financial parameters such as annual revenue, annual SG&A costs, customer satisfaction, and employee morale.

[0061] At processing block 504, processing logic classifies the applicable metrics by benefit group (e.g., annual revenue, annual SG&A costs, customer satisfaction, and employee morale).

[0062] At processing block 506, processing logic ranks the applicable metrics based on the user-provided rankings of the business challenges associated with the applicable metrics.

[0063] At processing block 508, processing logic adjusts the applicable metrics depending on the ranking to reflect diminishing returns (e.g., the metric with the ranking of 1 is not adjusted, the metric with the ranking of 2 is adjusted by 75%, the metric with the ranking of 3 is adjusted by 90%, and the metric with the ranking of 4 is adjusted by 100%).

[0064] At processing block 510, processing logic multiplies the adjusted metrics by revenue or SG&A allocation by industry.

[0065] At processing block 512, processing logic ensures that the sum of resulting benefits in the group is less than a maximum allowed benefit for the group. If the maximum allowed benefit is exceeded, all benefits in the group are adjusted.

Thus, Applicants submit that the specification provides sufficient disclosure in describing the estimation of benefits that are to be gained by an organization when one or more business challenges are successfully addressed. Therefore, Applicants respectfully request the reconsideration and withdrawal of this rejection against claims 1-7, 9, 11-24, 26-30 and 33-38.

Rejection of Claims under 35 U.S.C. §103

Claims 1-7, 9, 12-30, 26-30, and 33-38

Claims 1-7, 9, 12-30, 26-30, and 33-38 stand rejected under 35 U.S.C. § 103(a) as purportedly being unpatentable over Hack, et al., U.S. Publication No. 2003/0187675 (“Hack”), in view of SAP.com, 2002 (“SAP.com”). *See Office Action*, p. 4. Applicants offer amendments and respectfully traverse this rejection.

Independent claim 1 has been amended to recite “wherein the user specified information comprises information describing a level at which the organization performs in meeting each of the one or more business challenges.” In order to support its assertion that the combination of Hack and SAP.com teach the un-amended version of this limitation, the Office Action relies upon ¶¶ [0029] and [0030] of Hack, stating that these paragraphs disclose “a user selecting key performance indicators associated with the relevant business process, where the business processes are associated with the business challenges as taught in ¶ 23.” *See Office Action*, p. 5. However, the cited paragraphs define a key performance indicator (KPI) as simply “represent[ing] a factor that affects [a] business process.” (Emphasis added.) A KPI representing a factor that affects a business process does not describe the level at which an organization performs in meeting a business challenge. This is true even if “the business processes are associated with the business challenges.” For example, a KPI representing a factor that affects a business process might decrease in value, though the results of performing the business process actually improve, leading to an increase in the level at which an organization performs an associated business challenge. This can happen for at least the reason that more than one factor affects the business process. It can also happen for at least the reason that more than one business process affects the level at which an organization performs in meeting a business challenge.

Thus, even if the Office Action were to rely upon a theory of inherency, the cited paragraphs fail to teach “information describing a level at which the organization performs in meeting each of the one or more business challenges.” MPEP 2112(IV) states that “[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” (Emphasis in original.)

In addition, claim 1 has been amended to recite that “the information describing the levels comprises a user-specified ranking of organization performance for each of the one or more business challenges, and the user-specified ranking represents a ranking on a ranking scale.” In order to support its assertion that the combination of Hack and SAP.com might somehow teach the current version of this limitation, as found in the un-amended version of claim 2, the Office Action refers to the teaching of ¶ [0024] of Hack that “the user may rank the relative importance of each business scenario.” Realizing that this teaching fails to disclose the current version of this limitation, the Office Action states that

Hack, however, fails to explicitly disclose ranking organization performance with respect to each business challenge in the list.

It would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the business process valuation tool of the Hack and SAP.com combination to replace the prior art ranking of relative importance with the ranking of organization performance because one of ordinary skill in the pertinent art would have been able to carry out such a substitution, and the result of helping to define a set of strategies or processes are reasonably predictable.

*See Office Action, p. 7 (emphasis added).*

Applicants note that the Office Action fails to either cite an appropriate reference or take an Official Notice to support its assertion that the combination of Hack and SAP.com teach the

current version of this limitation. Applicants submit that the Office Action must at least take an Official Notice.

Further, Applicants submit that, even if an appropriate reference were forthcoming, Hack cannot be modified as proposed. Hack's user ranking of the relative importance of each business scenario cannot simply be replaced with a ranking of organization performance without Hack failing to function according to its intended purpose. Hack expects to use its user rankings to "help to define a set of strategies." Hack, ¶ [0024]. Since rankings of organization performance do not contain the same information as rankings of the importance of business scenarios, the former cannot simply be substituted for the latter in a process of defining a set of strategies. Thus, Applicants submit that there is no suggestion or motivation to replace Hack's user ranking of the relative importance of each business scenario with a ranking of organization performance. As stated in MPEP 2143.01(V), quoting *In Re Gordon*, 733 F.2d 900 (Fed. Cir. 1984.), "[i]f [the] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification."

However, even if replacing Hack's user ranking of the relative importance of each business scenario with a ranking of organization performance did not result in Hack failing to function according to its intended purpose, there would still be no reasonable expectation that the proposed modification will successfully help "to define a set of strategies or processes," as asserted by the Office Action as quoted above. This, follows from the fact that Hack expects to use its user rankings to "help to define a set of strategies," as discussed above, and contains no teaching that rankings of organization performance can be used instead. In fact, since rankings of organization performance do not contain the same information as rankings of the importance of business scenarios, there could be no expectation that the former can simply be substituted for

the latter in a process of defining a set of strategies. Thus, Applicants submit that, for at least this reason, the Office Action has failed to make a *prima facie* case of obviousness. As stated in MPEP 2143.02(I), quoting *In Re Merck & Co., Inc.*, 800 F.2d 1091 (CCPA 1986), “[t]he prior art can be modified or combined to reject claims as *prima facie* obvious as long as there is a reasonable expectation of success.”

Further, claim 1 has been amended to recite that “the estimating comprises adjusting a metric based on the ranking.” Applicants have found no teaching of this limitation in either Hack or SAP.com. Thus, Applicants submit that the combination of Hack and SAP.com fails to teach this limitation.

Since, as amended, the remaining independent claims 17, 23, 26, 28, and 35 contain similar limitations as independent claim 1, and since similar reasons have been given to support the rejection of these claims (*see* Office Action, pp. 6-7 and 11-13), Applicants respectfully request the reconsideration and withdrawal of this rejection against claims 1-7, 9, 12-30, 26-30, and 33-38, for at least the above reasons.

Claim 11

Claim 11 stands rejected under 35 U.S.C. § 103(a) as purportedly being unpatentable over Hack, as applied to claims 1 and 28, in view of Spangenberg et. al., U.S. Publication No. 2004/0260585 (“Spangenberg”). Applicants respectfully request the reconsideration and withdrawal of this rejection for at least the reason that claim 11 is dependent upon allowable base claim 1.

**CONCLUSION**

In view of the amendments and remarks set forth herein, the application is believed to be in condition for allowance and a notice to that effect is solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the Examiner is invited to telephone the undersigned at 512-439-5089.

If any extensions of time under 37 C.F.R. § 1.136(a) are required in order for this submission to be considered timely, Applicant hereby petitions for such extensions. Applicant also hereby authorizes that any fees due for such extensions or any other fee associated with this submission, as specified in 37 C.F.R. § 1.16 or § 1.17, be charged to deposit account 502306.

Respectfully submitted,

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